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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,784	06/26/2002	Barry J. Gilhuly	1400-1072 PC1	9501
54120 7590 01/25/2007 RESEARCH IN MOTION, LTD 102 DECKER CT. SUITE 180 IRVING, TX 75062			EXAMINER NGUYEN, HAI V	
			ART UNIT 2142	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/088,784

Applicant(s)

GILHULY ET AL.

Examiner

Hai V. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 63-101 and 113-121 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 63-101, 113-121 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 22 December 2006 has been entered.
2. This Office Action is in response to the communication received on 22 December 2006.
3. Claims 1-62, 112 were cancelled.
4. Claims 102-111 are cancelled.
5. Claims 63-101, 113-121 are presented for examination.
6. The double patenting rejections with patent # 6,701,378; the co-pending applications # 09/928,983 and 10/671,162 are pending.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 63, 93, 113, 120, 121 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

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reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

While the specification describes that, *"the messaging host system 230 is configured so as to forward a copy of all incoming data items destined for user B's inbox to a second host referred to herein as a wireless redirector host system 240. The wireless redirector host system 240 includes the wireless redirector program 242. Advantageously, data items destined for a user of the messaging host system 230 having a mobile communication device are continuously "pushed" to the wireless redirector host system 240 as they arrive at the messaging host system 230. Upon arrival at the redirector host system 240, a wireless redirector software program 22 operating at the system 240 determines whether such data items are user-selected data items to be pushed via a wireless network 222 to the user's mobile communication 220. In this manner, use items are advantageously pushed out to the mobile communication device 220 contemporaneously as they arrive to the messaging host system 230 so that the user need not be concerned about delays in receiving user-selected data items on the user's mobile communication device 220."* (Specification, pages 33-34), the amended claims 63, 93, 113, 120, 121 describe the limitation that *"without receiving a request from a wireless redirection host system, forwarding a copy of the data message from the messaging host system to the wireless redirector host system via a wide area network"*.

It is clearly that *the messaging host system 230 is configured so as to forward a copy of all incoming data items destined for user B's inbox to a second host referred to*

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herein as a wireless redirector host system 240. The specification does not describe clearly how "without receiving a request from a wireless redirection host system, forwarding a copy of the data message from the messaging host system to the wireless redirector host system via a wide area network" can be done?

9. Claims 63, 93, 113, 120, 121 contain the negative limitation.

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(b) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 63-82, 89-90, 93, 94, 96-98, 101, 113-118 and 120-121 are rejected under 35 U.S.C. 102(b) as being anticipated by AirMobile Communication Server Guide ("AirMobile Software For Lotus cc:Mail Wireless", User Guide version 1.1, 1995, hereafter "**AirMobile**").

12. As to claim 63, AirMobile discloses a method of redirecting data messages from a messaging host system (*Fig. 1; cc:Mail Post Office Server*) to a wireless mobile communication device (*Fig. 1, wireless cc:Mail Mobile user*), comprising the steps of:

receiving a data message at the messaging host system, wherein the messaging host system stores the data message in a first message store (*Fig. 1, Post Office Server's storage*) associated with a user of the wireless mobile communication device (*Fig. 1, Post Office Server receiving data message from user and storing it in the user's cc:Mail mailbox at The Post-Office server, pages 10-11*);

detecting the data message at the messaging host system (*Fig. 1, Post-Office Server recognizes the incoming data message from the user once the user has registered with his mailbox with the cc:Mail Post Office Server, pages 10-11*);

forwarding a copy of the data message (*AirMobile, transferring emails or cc:mails*) from the messaging host system (*Fig. 1, Post-Office Server*) to a wireless

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redirector host system (*Fig. 1, AirMobile Wireless for cc:Mail Server*) via a wide area network connection between the messaging host system and the wireless redirector host system;

storing the data message in a second message store (*cc:Mail Server's user mailbox account*) associated with the user of the wireless mobile communication device at the wireless redirector host system (*AirMobile, Fig. 1, e-mails or cc:Mails stored in AirMobile Wireless for cc:Mail Server*).

determining whether the data message stored in the second message store should be redirected from the wireless redirector host system to the user's wireless mobile communication device (*Fig. 1, pages 10-11, 25-27, 35, determining the routing or downloading or transferring of messages to mobile user from the AirMobile Wireless for cc:Mail Server*); and

if the data message should be redirected, then preparing the data message for redirection and transmitting a copy of the data message from the wireless redirector host system to the user's wireless mobile communication device (*Fig. 1, pages 10-11, 25-27, 35 describing the messaging system and the filtering of messages at the AirMobile Wireless for cc:Mail Server; an electronic envelope is inherently necessary to send messages between the host and the mobile device, pages 26-27*).

13. As to claim 64, AirMobile discloses wherein the data message is an e-mail message and the first data store is an e-mail inbox associated with an electronic mail system (*AirMobile, page 10*).

14. As to claim 65, AirMobile discloses, wherein the detecting step includes the steps of: determining whether a data message has been received at the messaging host system for a particular user of a wireless mobile communication device (*AirMobile, page 10*); and checking a forwarding file coupled to the messaging host system to determine whether the particular user's data messages should be forwarded to the wireless redirector host system (*AirMobile, page 10*).

15. As to claim 66, AirMobile discloses, wherein the forwarding file includes a list of network addresses associated with the wide area network connection where the user's data messages should be forwarded by the messaging host system (*AirMobile, page 10*).

16. As to claim 67, AirMobile discloses, further comprising the steps of:
configuring a set of filtering rules for use by the wireless redirector host system in determining whether the data message should be redirected to the user's wireless mobile communication device (*AirMobile, page 11-12*); and
providing an access mechanism that allows the user to remotely configure and reconfigure the filtering rules by connecting to the wireless redirector host system from a remote terminal (*AirMobile, page 11-12*).

17. As to claim 68, AirMobile discloses, further comprising the steps of:
configuring a user profile database for use by the wireless redirector host system in determining whether the data message should be redirected to the user's wireless mobile communication device (*AirMobile, page 11-12*); and providing an access mechanism that allows a system administrator of the messaging host system to

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remotely configure and reconfigure the user profile database by connecting to the wireless redirector host system from a remote terminal (*AirMobile*, page 11-12).

18. As to claim 69, AirMobile discloses, further comprising the steps of receiving the electronic envelope at the user's wireless mobile communication device; extracting the data message from the electronic envelope; and storing the data message within a memory of the mobile device (*AirMobile*, *an electronic envelope is inherently necessary to send messages between the host and the mobile device*, pages 26-27).

19. As to claim 70, AirMobile discloses, further comprising the steps of generating a reply data message at the wireless mobile communication device; packaging the reply data message into an electronic envelope and transmitting the electronic envelope to the wireless redirector host system (*AirMobile*, page 26 *describing messages transmitted by the wireless mobile device*, pages 26-27).

20. As to claim 71, AirMobile discloses, wherein the electronic envelope is addressed using an electronic address of the wireless redirector host system (*AirMobile*, page 26 *describing messages transmitted by the wireless mobile device to the director server will necessarily be addressed using the address of the redirector host system*, pages 26-27).

21. As to claim 72, AirMobile discloses, further comprising the steps of: extracting the reply data message from the electronic envelope at the wireless redirector host system (*AirMobile*, Fig. 1, pages 10-11, 25-27, 35);

reconfiguring the addressing information associated with the reply data message; and transmitting the reconfigured reply data message from the wireless redirector host system to the messaging host system (*AirMobile, Fig. 1, pages 10-11, 25-27, 35*).

22. As to claim 73, AirMobile discloses, further comprising the steps of:

receiving the reconfigured reply data message at the messaging host system; and storing the reply data message in the first message store associated with the user of the wireless mobile communication device (*AirMobile, Fig. 1, pages 10-11, 25-27, 35*).

23. As to claim 74, AirMobile will necessarily complete the claimed steps of:

receiving a reply received at the redirector host system, reconfiguring the addressing information associated with the reply, and transmitting the reconfigured reply data message to a destination using an electronic address included in the reply data message (*i.e., the messages sent from the mobile device are intended for outside recipients, so it must include the address of those recipients and must have addresses reconfigured upon redirection at the redirection host system*).

24. Claims 75-82 are disclosed in the same sections of AirMobile discussed previously.

25. Claims 89-90 are disclosed on pages 17 of AirMobile.

26. Claim 93 introduces identical limitations of claim 63, 67; therefore, it is rejected under the same rationale as in claims 63, 67.

27. Claim 94 is similar limitations of claim 67; therefore, it is rejected under the same rationale as in claim 67.

28. As to claim 96, AirMobile further discloses an interface for redefining or turning on or off the filtering mechanism that includes an activation/deactivation switch to turning on or off the operation of the wireless redirector host system for a particular user (*i.e., the "Enable" feature, see Figs. 2-5, for example*).

29. As to claim 97, AirMobile discloses accessing a user profile database coupled to the wireless redirector host system to verify that the user associated with the E-Mail message is an authorized user (*AirMobile, "password", page 17*).

30. As to claim 98, AirMobile discloses providing an access mechanism that allows a system administrator of the messaging host system to remotely configure and reconfigure the user profile database (*AirMobile, pages 11-12*).

31. As to claim 101, AirMobile discloses, wherein the wireless redirector host system and the wireless mobile device communicate through a wireless gateway system and a wireless communication network (*AirMobile, Fig. 1, wherein the "Mobidem" serves as the gateway*).

32. As to claim 113, AirMobile discloses the method comprising the steps of:
receiving data messages (*Airmobile, Fig. 1, emails or cc:Mail*) forwarded from the messaging host system (*Airmobile, Fig. 1, Post-Office Server*) to an address associated with the user of the wireless mobile communication device (*Airmobile, Fig. 1, AirMobile Wireless for cc:Mail Server*) at a wireless redirector host system (*Airmobile, Fig. 1, AirMobile Wireless for cc:Mail Server*) via a wide area network connection;

storing the forwarded data messages in a second message store associated with the user of the wireless mobile communication device at the wireless redirector host system (*Airmobile, Fig. 1, e-mails stored in AirMobile Wireless for cc:Mail Server*);

determining at the wireless redirector host system which of the forwarded data messages should be redirected to the wireless mobile communication device; and redirecting at least some of the forwarded data messages from the wireless redirector host system to the wireless mobile communication device using an address of the wireless mobile communication device via a wireless transmission network (*Fig. 1, pages 10-11, 25-27, 35 describing the messaging system and the filtering of messages at the AirMobile Wireless for cc:Mail Server*).

33. Claims 114-118 introduce identical limitations of claims 64, 68, 71, 72, 74; therefore, it is rejected under the same rationale as in claims 64, 68, 71, 72, 74.

34. Claim 120 corresponds to the system in means plus function claim of claim 113; therefore, it is rejected under the same rationale as in claim 113.

35. Claim 121 corresponds to the computer readable medium claim of claim 113; therefore, it is rejected under the same rationale as in claim 113.

Claim Rejections - 35 USC § 103

36. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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37. Claims 83-86, 99, 100, 119 are rejected under 35 U.S.C. 103(a) as being unpatentable over **AirMobile**, and further in view of **Nelson** U.S. patent # **6,061,718**.

38. As to claims 83-84, AirMobile does not explicitly disclose, wherein the messaging host system is run by an Internet Service Provider (ISP). Nonetheless, it is well known to use e-mail over the Internet on an e-mail service run by an ISP, as evidenced by Nelson (*Nelson, col. 5, line 65- col. 6, line 4*). Thus, it would have been obvious for the e-mail system taught by AirMobile to be run by an ISP because that would increase business with the ISP and would allow users to access mail from anywhere in the world.

39. As to claim 85, 99, the combined system of AirMobile and Nelson will perform the steps of including a forwarding database for detecting whether new data message received at the mail server should be forwarded to a wireless redirector host system, and for determining the electronic network address of the wireless redirector host system (*AirMobile, page 13, "Note"*).

40. As to claims 86, 100, the combined system of AirMobile and Nelson will necessarily connect the messaging host system (*i.e., ISP server*) and redirector host system over the Internet.

41. Claim 119 has similar limitations of claim 103; therefore, it is rejected under the same rationale as in claim 103.

42. Claims 87, 88, 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over **AirMobile**, and further in view of **Birrell** U.S. patent # **6,185,551**.

43. As to claims 87, 88, 95, AirMobile discloses, remotely configuring and reconfiguring the filtering rules and profile database using an interface, but does not

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disclose using a web-based interface. Nonetheless, the use of web-based interfaces for e-mail systems is well-known, as evidenced by Birrell (*Birrell, title, "Web-based electronic mail service..."*). It would have been obvious to use a web-based system as the interface in AirMobile because the Web is ubiquitous and accessible worldwide.

44. Claim 91 is rejected under 35 U.S.C. 103(a) as being unpatentable over **AirMobile**, and further in view of **LookSmart** ("Motorola Brings AirMobile Software Products to the DCPD Network; Motorola Provides Mobile Corporate cc:Mail Users with Flexibility to Use Any Major Wireless data Network", Business Wire, January 1996).

45. As to claim 91, LookSmart describes that AirMobile uses compression. It would have been obvious to include compression in the AirMobile system to save network bandwidth.

46. Claim 92 is rejected under 35 U.S.C. 103(a) as being unpatentable over **AirMobile**, and further in view of **Hertzog et al.**, U.S. Provisional Patent Application # **60/132,560**.

47. As to claim 92, AirMobile does not explicitly disclose, the data message is a calendar event message. Nonetheless, it is well known to send an e-mail message as calendar event message, as evidenced by Hertzog (*Hertzog, pages 27-28*). Thus, it would have been obvious for the e-mail system taught by AirMobile to be included by a calendar event message because that would increase business with the users and would allow users to access mail from anywhere in the world.

48. Further references of interest are cited on Form PTO-892, which is an attachment to this action.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai V. Nguyen whose telephone number is 571-272-3901. The examiner can normally be reached on 6:00-3:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hai V. Nguyen
Examiner
Art Unit 2142


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